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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,163	02/15/2002	Keiichi Sato	033808 0282103 PH-1435US	1280
38327	7590	08/17/2004	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			SISSON, BRADLEY L	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,163

Applicant(s)

SATO ET AL.

Examiner

Bradley L. Sisson

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-11 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As set forth in *Enzo Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).... We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co.*,

Art Unit: 1634

Ltd., 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

3. A review of the specification fails to find where any starting materials and reaction conditions have been set forth such that one of skill in the art could practice the claimed invention to the full extent of the claims' scope without having to resort to undue experimentation. The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001. As set forth in the decision of the Court:

" '[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.' *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) ('[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.').

"Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that 'a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.'). Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

"It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the

Art Unit: 1634

specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (Emphasis added)

4. The claimed device clearly relates to performing nucleic acid hybridization reactions as well as performing amplification reactions (e.g., PCR). Both of such technologies are recognized in the art as being problematic and require greater levels of enabling disclosure. As noted in *In re Fisher* 166 USPQ 18 (CCPA, 1970):

In cases involving predictable factors, such as that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.

In support of this position, attention is directed to the following teachings. Zhang et al.,

Bioinformatics, Vol. 19, No. 1, 2003, page 14, states:

It is widely recognized that the hybridization process is prone to errors and that the future of DNA sequencing by hybridization is predicated on the ability to successfully cope with such errors. However, the occurrence of hybridization errors results in the computational difficulty of the reconstruction of DNA sequencing by hybridization. The reconstruction problem of DNA sequencing by hybridization with errors is a strongly NP-hard problem. So far the problem has not been solved well.

Chan (US Patent Application Publication US 2002/0119455 A1):

[0018] In practice, Probe Up methods have been used to generate sequences of about 100 base pairs. Imperfect hybridization has led to difficulties in generating adequate sequence. Error in hybridization is amplified many times. A 1% error rate reduces the maximum length that can be sequenced by at least 10%. Thus if 1% of 65,536 oligonucleotides gave false positive hybridization signals when hybridizing to a 200-mer DNA target, 75% of the scored "hybridizations" would be false (Bains, 1997). Sequence determination would be impossible in such an instance. The conclusion is that hybridization must be extremely effective in order to generate reasonable data. Furthermore, sequencing by hybridization also encounters problems when there are repeats in sequences that are one base less than the length of the probe. When such

Art Unit: 1634

sequences are present, multiple possible sequences are compatible with the hybridization data. (Emphasis added.)

5. As set forth in Carrico, (US Patent 5,200,313) the extent and specificity of hybridization is affected by the following principal conditions:

- The purity of the nucleic acid preparation.
- Base compositions of the probe - G-C base pairs will exhibit greater thermal stability than A-T or A-U base pairs. Thus, hybridizations involving higher G-C content will be stable at higher temperatures.
- Length of homologous base sequences- any short sequence of bases (e.g., less than 6 bases), has a high degree of probability of being present in many nucleic acids. Thus, little or no specificity can be attained in hybridizations involving such short sequences. From a practical standpoint, a homologous probe sequence will often be between 300 and 1000 nucleotides.
- Ionic strength- the rate of reannealing increases as the ionic strength of the incubation solution increases. Thermal stability of hybrids also increases.
- Incubation temperature- Optimal reannealing occurs at a temperature about 25 - 30 °C below the melting temperature for a given duplex. Incubation at temperatures significantly below the optimum allows less related base sequences to hybridize.
- Nucleic acid concentration and incubation time- Normally, to drive the reaction towards hybridization, one of the hybridizable sample nucleic acid or probe nucleic acid will be present in excess, usually 100 fold excess or greater.

Art Unit: 1634

- Denaturing reagents- the presence of hydrogen bond-disrupting agents, such as formaldehyde and urea, increases the stringency of hybridization.
- Incubation- the longer the incubation time, the more complete will be the hybridization.
- Volume exclusion agents- the presence of these agents, as exemplified by dextran and dextran sulfate, are thought to increase the effective concentrations of the hybridizing elements thereby increasing the rate of resulting hybridizations.
- Further, subjecting the resultant hybridization product to repeated washes or rinses in heated solutions will remove non-hybridized probe. The use of solutions of decreasing ionic strength, and increasing temperature, e.g., 0.1X SSC for 30 minutes at 65 °C, will, with increasing effectiveness, remove non-fully complementary hybridization products.

6. In view of the breadth of scope claimed, the limited guidance provided, the unpredictable nature of the art to which the claimed invention is directed, and in the absence of convincing evidence to the contrary, the claims are deemed non-enabled by the disclosure. Accordingly, claims 3-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Response to argument

7. Applicant, at page 6 of the response received 28 April 2004, hereinafter the response, asserts that claims 3 and 10 are definite and are enabled by the disclosure. Such statements have been interpreted that all of claims 3-11 are enabled by the disclosure. Argument is also presented that "hybridization reactions, and DNA chips utilizing hybridization reactions are well known in the art as disclosed." In support of this position a brochure, with translation, have been provided.

Art Unit: 1634

8. The above argument has been fully considered and has not been found persuasive. The aspect of a product being offered for sale, or that a brochure, published post filing, describes how to use a device is not dispositive of the instant disclosure fully enabling the use of the claimed invention. While applicant has noted US Patent 6,482,640, applicant has not addressed how this patent document teaches how art-recognized difficulties are to be overcome, when as presented previously and reproduced above, the problems were not disclosed in the art until subsequent to the filing of the instant application.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 3-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: that which exists between the various elements of which the device is comprised. As presently worded, the claims are drawn to a "device," which has been interpreted as being but a single entity comprised of various elements wherein the elements have necessary structural connections. A review of claims 3-11 finds that there is no structural connection between the cap, the cases, the film and the tray. While applicant has inserted language defining the functionality of the "sheet" (claim 3), and the tray (claim 10), such does

Art Unit: 1634

not cure the issue of the claim not reciting any structural connections between the various elements. If in fact there does not exist any structural connections, applicant is urged to consider having the claims drawn to a "kit," which can be comprised of various non-connected elements or components.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Daigger Laboratory Equipment and Supplies Catalog (1999), page 593.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

Art Unit: 1634

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
10 August 2004